

REMARKS

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

Status of the Claims

Claims 1-20 are pending. Claims 1, 14 and 15 have been amended. Claims 19 and 20 have been added. No new matter has been added.

Status of the Specification

The Examiner has objected to the drawings for containing informalities. Formal drawing replacement sheets are submitted herewith. The replacement sheets contain Figures 1, 2, 3A-3C and 4A-4D. No new matter has been added. Applicants request withdrawal of this objection.

Claim Objections

The Examiner has objected to claims 1 and 14 for containing informalities. Applicants submit that amended claims 1 and 14 are in conformance with the Examiner's suggested correction. Claim 15 has been similarly amended. Applicants request withdrawal of this objection.

Rejection Under 35 U.S.C. § 103

Claims 1, 3, 9-11 and 15-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. RE 30, 666 to Mitchell et al. ("Mitchell") in view of U.S. Patent No. 6,240,391 to Ball et al. ("Ball"). Applicants respectfully traverse the rejection, and submit that the Examiner has not met the required burden of establishing a *prima facie* case of obviousness.

The Examiner contends that Mitchell discloses a method for synchronizing audio data to text data from a source, and segregating a source text data of a given format into a plurality of text sections. The Examiner states that "presumably the recordings are produced by recording in any order audio data portions each corresponding to a text section." (Detailed Action, page 3, item 8.) The Examiner acknowledges that Mitchell does not disclose converting each recorded audio portion into an audio data file, assembling the audio data files into the sequence corresponding to the given format of the source text data, and generating for the assembled data files a playback control file indicating points of navigation of the source text data.

However, the Examiner contends that Ball discloses that recorded audio may be converted into an audio data file to facilitate transmission over a network, and states that "they must be assembled into a sequence in order to be transmitted successfully." (Detailed Action, page 3, item 8.) The Examiner states that it would have been obvious for a person of ordinary skill in the art at the time of the invention to combine Mitchell and Ball to achieve the invention of independent claims 1 and 15.

Applicants submit that Mitchell discloses an audio visual recordation system for encyclopedic texts. (Mitchell, column 1, line 67 through column 2, line 2). Mitchell indexes and cross-references information pictorially and with text descriptions for audio visual presentation of encyclopedic texts. (Mitchell, column 1, lines 10-15). Ball is directed to a voice mail messaging system. (Ball, column 1, line 17). Through the use of a recipient's messaging system, Ball assembles a message that comprises a number of messaging elements, such as message fragments and embedded instructions that define the structure of the message and that reassemble the message fragments into a unified message for presentation to the recipient. (Ball, column 1, line 55 - column 2, line 1).

First, the Examiner's presumption that Mitchell's "recordings are produced by recording in any order" is not supported by any "concrete evidence in the record" (*See* MPEP § 2144.04(c), *citing In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).) In fact, there is no suggestion that a person of ordinary skill practicing the teachings of Mitchell would produce their recording other than serially in the intended order. Also the Examiner's statement that Ball's audio files "must be assembled into a sequence in order to be transmitted successfully" is similarly not supported. It is most likely that the audio files are already in sequence. Accordingly, Applicants submit that the Examiner is relying on personal knowledge and respectfully request that the Examiner supports this personal knowledge with affidavits containing data as specific as possible pursuant to 37 C.F.R. §1.104(d)(2). In accordance with § 1.104(d)(2), Applicants are permitted to contradict or explain such affidavits with affidavits of the Applicants or other persons. Applicants submit that without supporting evidence, the

Examiner has impermissibly relied on personal knowledge and, thus, has not established a *prima facie* case of obviousness.

Secondly, Applicants submit that neither Mitchell nor Ball singly, or in combination, disclose or suggest the step recited in claim 1 of “recording in any order audio data portions each corresponding to a text section.” The Specification describes known software packages that allow for recording the audio data to form an audio book in a pre-set format. These prior art software systems first establish a playback control format prior to recording any audio data. Subsequent to the creation of the playback control format, the recording of the audio data for one or more text sections can be done in any order.

Claim 1 recites the step of “generating for said assembled data files a playback control file indicating points of navigation of the source text data.” Applicants submit that the assembled data files are required to exist prior to the generating step, in order for the step to generate “for said assembled data files a playback control file.” As recited in claim 1, the assembled data files are audio data files formed from converting recorded audio portions. Therefore, the audio portions are recorded prior to conversion into the data files. Thus, the invention of claim 1 records audio data prior to the generation of the playback control file. In contrast the prior art, including Mitchell and Ball, does not disclose, or suggest, generating the playback control file subsequent to recording the audio portions.

Thirdly, Applicants submit that the combination of Mitchell and Ball destroys the intended purpose of Mitchell and results in an inoperable device. Ball does not disclose the steps of “segregating a source text data of a given format into a plurality of text sections” and

claim 4 depends from claim 1, claim 4 is patentable over the combination of Mitchell, Ball and Lowe for at least the same reasons as claim 1.

Moreover, Lowe does not disclose a narrator that produces a mark of the beginning and end of the text section recorded. The Examiner contends that Frame position 6 and Frame position 7 supports disclosure in Lowe for the marks required by the invention as defined in claim 4. Lowe's frames, however, are not produced by the narrator as required by the invention as defined by claim 4. Rather, Lowe's frames are part of a predetermined, standardized set of cuing and timing points. (Lowe, column 7, lines 41-47). This provides another reason why claim 4 is patentable over the combination of Mitchell, Ball and Lowe, either singly or in combination. Therefore, for the foregoing reasons, Applicants request withdrawal and reconsideration of the rejection of claim 4.

Claims 5, 13, 14 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of U.S. Patent No. 6,335,768 to Reinold et al. ("Reinold"). Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of Reinold and Barbara. Claims 7-8 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of Reinold and U.S. Patent No. 5,850,629 to Holm.

Reinold was cited for its disclosure of the encoding of audio into formats such as RealAudio and WAV, and storage on CD-ROMS and DVDs. Reinold, however, in no way discloses recording audio in any order as required by claims 1 and 15. Holm was cited for its disclosure of a text-to-speech production from selected sections of documents in a display.

However, Holms fails to disclose recording audio in any order as required by claims 1 and 15. Because claims 5-8, 13, 14, 17 and 18 depend from either claims 1 and 15, they are patentable for at least the same reasons.


Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitchell and Ball in view of U.S. Patent No. 6,003,090 to Puranik. Puranik was cited to show the advantages of using HTML, but it does not disclose recording in any order or the other features of claim 1. Because claim 12 depends from claim 1, it is patentable for at least the same reasons as claim 1.

Applicants request withdrawal and reconsideration of these rejections.

CONCLUSION

Each and every point raised in the Office Action dated January 5, 2004 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-20 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

Respectfully submitted,


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